

REMARKS

The Examiner is thanked for the clarity and conciseness of the Office Action, and for the citation of references, which have been studied with interest and care.

This Response is in response to the Final Office Action mailed February 13, 2003. In the Office Action, claims 3-6, 9-13 and 17-57 stand rejected. Applicant has amended independent claims 3, 9, and 17 to clarify the claims. Accordingly, claims 3-6, 9-13, and 17-57 remain pending in the application. Reconsideration in light of the amendments and the remarks made herein is respectfully requested. Applicant respectfully submits that the claims are now in condition for allowance, or in better form for appeal. If the Examiner believes a teleconference would be useful in the prosecution of this case, the Examiner is invited to contact the Applicant's attorney.

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejected claims 3-6, 9-13, and 17-57 under 35 U.S.C. § 103(a) as being unpatentable over O'Toole, Jr. et al. (US Patent No. 6,279,112 B1) in view of Davis et al. (US Patent No. 5,796,952).

Applicant respectfully traverses the Office Action's § 103(a) obviousness rejection in its entirety, in light of the amended independent claims 3, 9, and 17.

A *prima facie* obviousness rejection requires that three basic criteria be met. First, there must be some teaching, suggestion, or motivation, either in the references themselves, or in the knowledge generally available to one skilled in the art, to modify the reference or to combine the references. Second, there must be some reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. MPEP § 2142; In re Vaeck, 947 F. 2d. 488 (Fed. Cir. 1991).

Furthermore, with regards to obviousness, as recently and aptly stated by the Federal Circuit in *In re Kotzab*, 55 U.S.P.Q.2D (BNA) 1313, 1316-1317 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *...Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.* (Emphasis added).

Applicant respectfully submits that the limitations of independent claims 3, 9, and 17, as amended, are not taught, suggested, or rendered obvious by O'Toole alone, or in combination with Davis, and that, in fact, O'Toole teaches away from Applicant's amended claims limitations.

Applicant's independent claims 3, 9, and 17 have been amended such that they now all generally recite: a user rule page containing information obtained automatically from the target computer *by a first agent*... the first agent having a triggering program to filter information and to determine whether the information is relevant to the user rule page, wherein the first agent automatically gathers information from the target computer without the user's authorization...a rulebook to provide a rule based on the user rule page... the rule controlling the content to be transmitted from a database to the target computer; along with other limitations.

In the Final Office Action, the previous independent claims 3, 9, and 17 were rejected as being obvious over O'Toole. Applicant respectfully submits that O'Toole does not teach, suggest, or render obvious the claim limitations of amended independent claims 3, 9, and 17;

and in fact, Applicant respectfully submits that O'Toole **teaches away** from Applicant's amended independent claims.

Starting on page 4, paragraph 5, of the Final Office Action, the Office Action states that: a user rule page containing information obtained from the target computer by a first agent, in which the first agent has a triggering program to filter information and to determine whether the information is significant...wherein the smart digital offer object functions as the claimed "first agent", is taught by O'Toole, along with various other elements of the claims (citing O'Toole column 7, line 24 through column 8, line 4).

Applicant respectfully submits that O'Toole does not teach, suggest, or render obvious Applicant's amended claim limitations related to a user rule page containing information obtained automatically from the target computer *by a first agent...wherein the first agent automatically gathers information from the target computer without the user's authorization*; and, in fact, **teaches away** from these claim limitations.

As stated in the section of the O'Toole patent cited by the Office Action, O'Toole teaches:

The client computer fetches a document of web-based information from the offer-providing server that contains a smart digital offer object (step 118)...The client computer activates the smart digital offer object (step 120), and the smart digital offer object attempts to observe the parameters of the execution environment at the client machine, including the presence of coupons, and possibly other information such as a purchasing history recorded on the client computer....If the smart digital offer object attempts to observe the purchasing history or certain other user-specific information, the client computer asks the user whether the user wishes to reveal the information (step 122). The user indicates whether release of the information is authorized (step 124), and the smart digital offer object then examines the coupon (including the coupon's authenticator), digital receipts (including authenticators) and other user-specific information authorized to be revealed by the user, and presents to the user an offer of a product or service (step 126)...When the user accepts the offer (step 128) the client computer sends a message to the offer-providing server indicating that the user has accepted the offer, or sends the message to an intermediary server that is trusted by the client computer to maintain the confidentiality of user-

specific information and is trusted by the offer-providing server to verify the terms on which the offer was accepted (step 130)...The offer-providing server then fulfills the offer by causing the offered product or service to be provided to the user (step 134). (O'Toole, column 7, line 24 through column 8, line 21) (Emphasis Added).

Thus, O'Toole does not teach an "agent", as in Applicant's amended independent claims 3, 9, and 17, in which a user rule page contains information obtained automatically from the target computer *by a first agent...wherein the first agent automatically gathers information from the target computer without the user's authorization*. Applicant's patent specification discloses an "agent," as typically used in communication network applications, wherein the "agent" automatically gathers information from the target computer *without the user's authorization*. O'Toole teaches the exact opposite.

In O'Toole the user is asked whether the user wishes to reveal user information, and only after specific authorization from the user, can the user information be gathered and transmitted to a server. Therefore, O'Toole **teaches away** from Applicant's claimed invention. As stated in the MPEP, "[i]t is improper to combine references where the references teach away from their combination." MPEP § 2145 (emphasis added). Accordingly, O'Toole cannot be used as a reference for obviousness and independent claims 3, 9, and 17 should be allowable.

In the previous Final Office Action, definitions related to the term "agent" were provided. Applicant is appreciative of the thoroughness of the Office Action. However, Applicant would like to point out that, as stated in MPEP § 2111.01, the patentee is his/her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well-known definition. In O'Toole, the patentee defined an offer object, not as a traditional agent, but as an offer object to perform the function of asking a user whether the user wishes

to reveal user information, and only after specific authorization from the user, allowing user information to be gathered and transmitted to a server.

Thus, O'Toole does not teach, suggest, or render obvious Applicant's amended independent claims 3, 9, and 17, in which a user rule page contains information obtained automatically from the target computer *by a first agent...wherein the first agent automatically gathers information from the target computer without the user's authorization*; and in fact teaches away from Applicant's amended independent claims 3, 9, and 17. Moreover, O'Toole neither alone, nor in combination with Davis, teaches, suggests or renders obvious these claims limitation in combination with Applicant's other claims limitations, such as, a rulebook to provide a rule based on the user rule page, the rule controlling the content to be transmitted from a database to the target computer, the rule stored in form of a condition-action pair, a condition in the condition-action pair being a hardware characteristic of the target computer, etc.

Accordingly, Applicant respectfully requests that the rejections of independent claims 3, 9, and 17 be withdrawn, and that these independent claims be allowed. Further, Applicant respectfully submits that the dependent claims are allowable because they are dependent upon allowable base claims, respectively.


CONCLUSION

In view of the remarks made above, it is respectfully submitted that pending claims 3-6, 9-13, and 17-57 define the subject invention over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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Dated: April 7, 2003


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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on: April 7, 2003.

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